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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/945,006	08/31/2001	J. Pat Evans	10368/24701	1607
24349	7590	06/07/2004	EXAMINER	
WILLIAM R. GUSTAVSON SUITE 1185 9330 LBJ FRWY. DALLAS, TX 75243			STASHICK, ANTHONY D	
			ART UNIT	PAPER NUMBER
			3728	

DATE MAILED: 06/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/945,006	Applicant(s) EVANS ET AL. CN	
	Examiner Anthony D Stashick	Art Unit 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 April 2004, the request for RCE.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 26, 2004 has been entered.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 2-4 and 6-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Within the context of claims 2-4 and 6-17 the applicant uses portions of the human foot, i.e. first metatarsal head, third metatarsal head, Astragalus etc., to describe the positioning of portions of the

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claimed invention. Since these portions of the human foot differ in placement, size and shape on people who wear the same sized shoe, it is difficult to determine the metes and bounds of the claims. Applicant continues to claim portions of the human body, i.e. parts of the foot, rather than claiming the insole surface with respect to the claimed insole. Applicant cannot claim a human body part in a utility application. Since applicant is claiming portions of the insole located with respect to portions of the foot, this inherently claims the foot portions in the claim, which is not allowed in a utility application, i.e. unless one has the foot in the shoe, one cannot determine the points claimed by the applicant. As the position of the bones of the foot on, for example, one men's size 9 foot can be located differently and fall on different points than another men's size 9 foot (as some forefoot regions can be longer than others who have a longer heel region), the position of the cited locations cannot be properly determined.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-6, 8-11, 13-15 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Schroer, Jr. et al. 5,282,326. Schroer, Jr. et al. '326 discloses all the limitations of the claims including the following: an insole 2 having a raised arch support portion (see Figure 5a, area 22) with the peripheral contour of the arch section generally conforming to the longitudinal arch and transverse arch of the plantar surface of a user's foot (see Figures 1 and 3); the peripheral contour is defined by a curve having a first endpoint located on a medial edge of the insole (see Figure 1) generally corresponding to a forward most medial point of the longitudinal arch; a second endpoint located rearward of the first endpoint on the medial edge of the insole (also Figure 1); the curve extends forwardly and laterally (Figure 1) from the first endpoint through a point generally corresponding to a midway point between second and third metatarsal heads of the foot and rearwardly along the medial edge of the fifth metatarsal head of the foot then rearwardly and medially to the second endpoint (see Figure 1); the curve extends across a point generally corresponding to a cuboid of the foot; the raised arch support portion forms part of the foot bed (see Figure 3); the raised

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arch support portion has a maximum height dimension substantially midway between a first metatarsal head and an Astragalus of the human foot (see Figure 3); the raised arch support portion has a maximum height dimension midway between a Tibialis Anticus of the human foot (see Figure 3); the insole has dimensions that generally correspond to a human foot of predetermined size; the insole is capable of supporting substantially all of the plantar surface of the human foot (see Figure 3); a surface layer 12 provided on the upper surface of the foot bed; the foot bed has a hind foot region and a forefoot region and is made of flexible material (see col. 5, line 49-col. 6, line 66).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 7, 12 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schroer, Jr. et al. 5,282,326. Schroer,

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Jr. et al. '326 discloses all the limitations of the claims as noted above. Although Schroer, Jr. et al. '326 does not specifically state the height of the arch support portion, it appears that it would have been a mere matter of design testing an evaluation to find what the average height is for the arch portion of a persons foot and use that height to be the support height of the arch support portion since this portion would be used to support the arch of the average user. With respect to claim 16, it is well known in the art of insole making to make the top layer of an insole out of a textile material to aid in giving comfort to wearing the shoe and to aid in wicking away perspiration.

Response to Arguments

7. Applicant's arguments filed April 26, 2004 have been fully considered but they are not persuasive. Applicant argues that Schroer, Jr. et al. does not disclose an insole with a raised arch support portion defined by a curve having a first end point located on a medial edge of the insole corresponding generally to a forward most medial point of the longitudinal arch and a second endpoint located rearward of the first endpoint on a medial edge of the sole wherein the curve extends forwardly and laterally from the first endpoint through a point generally

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corresponding to a midway point between a second metatarsal head and a third metatarsal head of the foot, extending rearwardly along a medial edge of the fifth metatarsal of the foot and extending rearwardly and medially to the second endpoint. This argument is not clearly understood. When comparing Figure 1 of Schroer, Jr. et al. to Figure 1 of the instant application, it can be seen that the raised arch support portion of Schroer Jr. et al. follows the same path as that of the instant application with Figures 3, 5A and 5B showing the raised arch. Therefore, With respect to applicant's arguments directed to Figure 3 of Schroer, Jr. et al., these arguments are also not clearly understood. When comparing Figure 3 of Schroer, Jr. et al. to Figure 4 of the instant application, the location of the curve of Schroer Jr. et al. are in the same area as that claimed by the applicant.

Conclusion

8. This is an RCE of applicant's earlier Application No. 09/946,006. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in

this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers or other general questions should be directed to Tech Center 3700 Customer Service at (703) 306-5648, email CustomerService3700@uspto.gov.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony D

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Stashick whose telephone number is 703-308-3876. The examiner can normally be reached on Monday through Thursday 8:00 am-4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 703-308-2672. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-1148.

Other helpful telephone numbers are listed for applicant's benefit.

Allowed Files & Publication	(703) 305-8322
Assignment Branch	(703) 308-9287
Certificates of Correction	(703) 305-8309
Drawing Corrections/Draftsman	(703) 305-8404/8335
Fee Increase Questions	(703) 305-5125
Intellectual Property Questions	(703) 305-8217
Petitions/Special Programs	(703) 305-9282
Terminal Disclaimers	(703) 305-8408
Informal Fax for 3728	(703) 308-7769

If the information desired is not provided above, or has been changed, please do not call the examiner (this is the latest information provided to him) but the general information help line below.

Information Help line	1-800-786-9199
Internet PTO-Home Page	http://www.uspto.gov/



Anthony D Stashick
Primary Examiner
Art Unit 3728

ADS
May 30, 2004